

REMARKS/ARGUMENTS

Claims 1-20 are currently a part of this application.

Claims 1-3, 5-8, 10, 11 and 13-20 have been rejected. Claims 4, 9 and 12 were previously withdrawn.

I. Claim Rejections Under 35 U.S.C. § 102

Claims 1-3, 5-8, 10, 11 and 13-20 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Publication No. US 2002/0114940 to Clemens et al. (hereafter "*Clemens*"). The Examiner asserts that *Clemens* discloses a top coating composition (paragraph [0020]) comprising a mixture of a polymeric binder (paragraph [0022] and paragraphs [0114]-[0118]), heat expandable graphite particles (paragraph [0029]), a polymeric carrier (paragraph [0129]) and an effective amount of a pigment (paragraph [0024]) that is deemed to be capable of providing a coating that has an initial energy efficiency rating greater than or equal to 0.65 for a low-sloped roof, or an initial energy efficiency rating greater than or equal to 0.25 for a steep sloped roof. According to the Office Action, the mixture in *Clemens* has a solids content from about 50-75% of which 1-10 wt. % is expandable graphite particles (paragraphs [0022]-[0029] and paragraph [0187]). The Office Action states that the mixture may also be cured [paragraph [0169]].

To anticipate a claim, a reference must: (1) disclose every element of the challenged claim; and (2) enable one skilled in the art to make the claimed subject matter. See *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996). It is not sufficient that each element be found somewhere in the reference, the elements must be "arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458

(Fed. Cir. 1984). Further, the reference must be sufficiently clear so as to prove the existence of each and every element in the reference. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1473 (Fed. Cir. 1997).

Applicant traverses the rejection under 35 U.S.C. § 102 and requests reconsideration. With all due respect to the Examiner, *Clemens* does not anticipate claim 1 since *Clemens* does not recite each and every element of claim 1 arranged as in the claim. (*Richardson v. Suzuki Motor Co.*, 8 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). (emphasis added). The Examiner has merely picked and chosen the individual components of the top coating composition of claim 1 from the *Clemens* application. *Clemens* is directed to an asphaltic coating system that comprises a basecoat of a thermosetting asphalt, extended chemically cross-linked – urethane/epoxy hybrid basecoat on a substrate, and a thermoplastic powder coating topcoat overlying at least the basecoat. *Clemens* does not, however, recite a non-asphaltic top coating composition as recited in amended claim 1 of the present application. *Clemens* teaches a completely different coating composition from that of the instant claims. *Clemens* recites a coating system that comprises a basecoat of an thermosetting asphalt. (emphasis added). Specifically, *Clemens* teaches a basecoat of petroleum asphalt. (*Clemens*, Abstract and paras [0009], [0011]-[0012] and [0151]-[0159]) Unlike the non-asphaltic composition of the instant claims, which has enhanced reflectivity and serves to reduce the flammability of the coating composition, the asphalt as used in the coating in *Clemens* is typically flammable. (emphasis added). As such, the chemical compositions of the coating of claim 1 and that in *Clemens* is substantially different. Furthermore, expandable graphite particles (i.e., flame retardants) are recited as an optional ingredient in the composition of *Clemens*. (*Clemens*, para [0029]).

Support for the amendment to claim 1 is found in the coating compositions set forth in TABLES 1-4 in the instant application (paras [0052-0056]). As disclosed there, no asphalt included in the top coat composition.

Accordingly, since *Clemens* does not teach each and every element of claim 1 arranged as in the claim, claim 1 is not anticipated, and Applicants thus respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b).

Since claims 2-3, 5-8 and 13-14 depend directly from amended claim 1, these claims incorporate all the limitations of amended claim 1 and are likewise not anticipated for the same reasons as asserted with regard to amended claim 1.

Additionally, independent claim 15 as amended, is not anticipated for the same reasons as recited with respect to independent claim 1. Specifically, *Clemens* does not recite a non-asphaltic coating, as in claim 15 of the present invention, comprising a cured reaction product of a polymeric binder, heat expandable graphite particles, a polymeric carrier and a pigment, said cured reaction product having an initial energy efficiency rating greater than or equal to 0.65 when applied to low-sloped roof, or an initial energy efficiency greater than or equal to 0.25 when applied to a steep-sloped roof. (emphasis added). The asphaltic topcoat as a stand-alone product according to *Clemens* (paragraphs [0114]-[0119]) is a powder applied over a base coat, is not a non-asphaltic coating that comprises a cured reaction product which incorporates: a polymeric binder, heat expandable graphite particles, a polymeric carrier and a pigment, and which has an initial energy efficiency rating greater than or equal to 0.65 when applied to low-sloped roof, or an initial energy efficiency greater than or equal to 0.25 when applied to a steep-sloped roof, as recited in claim 1 of the present application. Flame retardant particles are disclosed in *Clemens* only as an optional ingredient. (*Clemens*, para [0029]).

Accordingly, *Clemens* does not teach a non-asphaltic coating and thus does not recite each and every element of claim 15 arranged as in the claim and thus claim 15 is not anticipated.

Claims 16-20 depend directly or indirectly from independent claim 15 and incorporate all the limitations of claim 15 therein. As such, claims 16-20 are not anticipated for the same reasons as asserted with regard to claim 15.

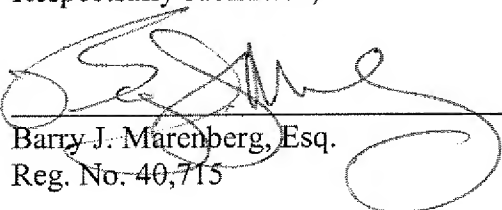
II. Conclusion

In view of the aforementioned remarks and amendments, the Applicants believe that each of the pending claims is in condition for allowance. If, upon receipt and review of this amendment, the Examiner believes that the present application is not in condition for allowance and that changes can be suggested which would place the claims in allowable form, the Examiner is respectfully requested to contact Applicants' undersigned counsel at the number provided below.

Please charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 03-1250 (Ref. No. FDN-2799).

Respectfully submitted,

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